

REMARKS

Claims 1, 8, 10, 19 and 20 have been amended. No claims have been added or canceled. Therefore, claims 1-20 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Section 103(a) Rejections:

The Examiner rejected claims 1-3, 8, 12-15 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Parcel Insurance Plan (www.pipinsure.com) (hereinafter “PIPinsure”) in view of Keuper (DE 44 46 203 A1) (hereinafter “Keuper”) and Luchs et al. (U.S. Patent 4,831,526) (hereinafter “Luchs”), claims 4, 6, 9 and 19 as being unpatentable over PIPinsure, Keuper and Luchs and further in view of Kadaba et al. (U.S. Patent 6,285,916) (hereinafter “Kadaba”), claims 5, 7, 10 and 11 as being unpatentable over PIPinsure, Keuper and Luchs and further in view of Official Notice, claim 16 as being unpatentable over PIPinsure, Keuper and Luchs and further in view of eBay, claim 17 as being unpatentable over PIPinsure, Keuper and Luchs, further in view of Chen et al. (U.S. Patent 5,504,674) (hereinafter “Chen”) and further in view of knowledge generally available to one having ordinary skill in the art, and claim 18 as being unpatentable over PIPinsure, Keuper and Luchs and further in view of Kepler (U.S. Patent 5,347,845). Applicant traverses these rejections for at least the following reasons.

In regard to claim 1, contrary to the Examiner’s assertion, the combination of cited art fails to teach or suggest a method for arranging insurance for an item, wherein the method comprises, in part, receiving a request, wherein the request is a request to insure the item during shipment from the origination to the final destination. The Examiner cites page 8 of PIPinsure that includes a form to request a savings quote. Clearly, a request *for a savings quote* is not a request *to insure a particular item that is actually being shipped*. PIPinsure discloses a series of questions a user can answer to “request a free quote on your package insurance needs.” The questions pertain to *general characteristics* of a user’s shipping *habits* including *average*

number of packages insured per day and *average* value per insured package. Thus, instead of a specific package, the form addresses packages in the aggregate on average. A request for a saving quote regarding aggregated average shipments over days or months cannot be considered a request to insure a particular item during shipment from an origination to a final destination. Additionally, a business typically provides a *quote* to help facilitate a customer's decision on whether to order a service or product. **Thus, a quote is requested before a customer actually decides whether to request a given service or product.** Furthermore, PIPinsure fails to disclose an origination or a final destination for a specific item. Thus, for numerous reasons, PIPinsure clearly does not teach or suggest receiving a request to insure the item being shipped from an origination to a final destination. In the Office Action mailed January 11, 2008, the Examiner acknowledges that PIPinsure fails to teach the *request* of claim 1. The Examiner relies on the teachings of Luchs to teach this limitation. However, Luchs also fails to teach the request of claim 1, as described in more detail below.

The Examiner also cites the Abstract of Luchs. However, nowhere does Luchs, whether considered singly or in combination with PIPinsure and Keuper, teach or suggest receiving a request, wherein the request is a request to insure the item during shipment from the origination to the final destination. The Abstract of Luchs is reproduced below:

A fully computerized insurance system is provided for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts. A central processor, including a data bank into which data is written and from which data is read, this data including information regarding the risk to be insured, client information, insurance premium information and predetermined text data for incorporation with insurance contracts, is interconnected with plural terminals, including input and display apparatus, to permit data to be entered and retrieved from the central processor. The central processor is also provided with the capability of merging entered or stored data with predetermined text data to compile data embodying a final insurance document. This data is then communicated to a printer for printing of the insurance document.

Luchs, even when combined with the other cited references, fails to mention anything at all about a request to insure the item during shipment from the origination to the final

destination, much less receiving such a request. Instead, Luchs teaches a computerized insurance system for processing and preparing application for insurance, premium quotations, and insurance contracts. While Luchs mentions “a risk to be insured,” Luchs fails to mention anything at all about a request to insure an item during shipment from the origination to the final destination. Accordingly, Luchs, whether considered singly or in combination with the other cited references, fails to teach or suggest the specific limitations of Applicant’s claim.

Keuper describes a barrel tag transponder that stores data pertaining to the contents of the barrel, such as identification, filling date, beer grade, etc. Keuper has nothing to do with a request to insure an item. Also, Keuper is non-analogous art. Thus, PIPinsure, Luchs and Keuper, taken singly or in combination, fail to teach or suggest a request to insure an item being shipped from an origination to a final destination.

Furthermore, the Examiner has not stated a proper reason as to why one of ordinary skill in the art would have been motivated to combine the teachings of Luchs with the teachings of PIPinsure and Keuper. The Examiner asserts, “One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Luchs with the teachings of PIPinsure and Keuper with the motivation of insuring items to be shipped (Luchs: abstract). Luchs fails to teach anything at all about insuring items to be shipped; the Examiner’s reasoning is completely circular and conclusory. Furthermore, PIPinsure discloses “Parcel Insurance Plan was founded in 1966 with the mission to provide dramatically lower-cost package insurance to business shippers...” (PIPinsure, page 2, first paragraph; see also PIPinsure, page 4, item 4). **Accordingly, one seeking to “insur[e] items to be shipped” would simply use the teachings of PIPinsure alone.**

Further in regard to claim 1, the Examiner’s combination of cited art also fails to teach or suggest searching a database for a cost effective insurance for the item, wherein the cost effective insurance provides a specified level of insurance coverage for the item during shipment. The Examiner asserts PIPinsure discloses this

limitation on page 1. However, page 1 of PIPinsure merely discloses a simple table of annual potential savings dependent on a declared package value and number of shipments per day. A table of potential savings is not the same as searching a database for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the particular item during shipment. In fact, a table of potential savings on a web page is completely different than searching a database for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the item. Thus, PIPinsure, Keuper and Luchs, taken singly or in combination, fail to teach or suggest searching a database for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the item.

In the Response to Arguments section of the Final Office Action mailed April 3, 2007, the Examiner responds to Applicant's arguments by citing page 18 of PIPinsure. However as noted above, page 18 of PIPinsure has nothing to do with *insuring* an item. Instead, page 18 compares the cost of expedited shipping over regular shipping. **Nothing about the table illustrated on page 18 has anything whatsoever to do with insuring an item or about searching a database for a cost effective insurance.** Thus the Examiner's contention the table on page 18 somehow teaches or suggests searching a database for a cost effective insurance that provides a specified level of insurance coverage for a particular item is clearly erroneous.

Without providing any actual evidence, the Examiner also provides his own speculation that the United States Postal Service, Federal Express, United Parcel Service, etc., "developed and used" "the concept of searching insurance databases having specified levels of insurance coverage for items" "well prior to Applicant's claimed invention." However, once again, the Examiner is rejecting Applicants' claim based solely on the Examiner's own speculation regarding the specific functionality of shipping services (e.g., USPS, FedEx, UPS, etc) "well prior to Applicant's claimed invention." In spite of Applicant's previous request for the Examiner to provide actual evidence supporting his reliance on United States Postal Service, Federal Express and/or United Parcel Service as

prior art, the Examiner has not provided any proper prior art reference that clearly demonstrates that one or more of these services included searching a database for a cost effective insurance that provides a specified level of *insurance* coverage for the particular item. **There is no evidence of record to support the Examiner's assertions.** Moreover, it again appears that the Examiner is again attempting to boil Applicant's claim down to a "gist" of the invention. As discussed above, this is not a proper basis for rejection.

Further regarding claim 1, the cited art fails to teach or suggest generating a data file comprising at least item information indicative of the item and insurer information indicating one or more terms of insurance. The Examiner cites page 8 of PIPinsure that discloses a form to request a savings quote. As described above, the form includes text fields to allow a user to enter answers to questions pertaining to a user's aggregated shipping habits. However, a form on a web page that allows users to request a savings quote is not the same as generating a data file comprising at least item information indicative of the item and insurer information indicating one or more terms of insurance. As discussed above, PIPinsure discloses a series of questions that pertain to general characteristics of a user's shipping *habits* including *average* number of packages insured per day and *average* value per insured package. **However, *insurer information indicating one or more terms of insurance* is not disclosed in any of the questions presented in the savings quote form of PIPinsure. Moreover, PIPinsure makes no mention of generating any data file.** The mere existence of a web form for requesting a saving quote regarding a user's aggregated shipping habits does not imply the generation of a file including specific item information indicative of the item and insurer information indicating one or more terms of said cost effective insurance. Clearly, PIPinsure, Luchs, and Keuper, taken singly or in combination, fail to teach or suggest generating a data file comprising at least item information indicative of the item and insurer information indicating one or more terms of said cost effective insurance.

The Examiner's response to Applicant's argument in the Final Office Action mailed April 3, 2007 is merely speculation unsupported by any evidence or technical

reasoning. Specifically, the Examiner restates the unsupported assertion that “PIPinsure does indeed teach and suggest generating a data file comprising at least item information and insurer information.” The Examiner then states, again without any supporting evidence or technical reasoning, that “those of ordinary skill in the art are well aware of this technique that was developed as used well prior to Applicants’ claimed invention”, making reference to United States Postal Service, Federal Express, United Parcel Service, etc. However, the Examiner’s unsupported speculations do not refute Applicant’s argument as to the actual teachings of the evidence of record, namely that the discussion of PIPinsure’s savings quote at page 8 (as cited by the Examiner) does not teach, suggest or mention, even if combined with the Examiner’s other cited art, generating a data file including at least item information and insurer information. Instead, The Examiner appears to arguing that the mere existence of a WEB-based entry form somehow inherently includes generating a data file including at least item information and insurer information, as recited in Applicants’ claim. However, as noted above, it is well established that mere statements of conclusion or opinion are not sufficient for a proper rejection. Instead, the Examiner must provide actual evidence to show that the characteristic relied upon, in this case generating a data file including at least item information and insurer information, is necessarily present in the reference. Such is not the situation in the present case.

Additionally in regard to claim 1, the cited art fails to teach or suggest storing the data file, containing both item information and insurer information, in a memory device that accompanies the item during shipment. The Examiner admits that PIPinsure fails to disclose this limitation and relies on Keuper to disclose storing the data file in a memory device that accompanies the item. As noted above, Keuper describes a barrel tag transponder that stores data pertaining to the contents of the barrel. Keuper describes on page 8, lines 3-11:

This problem is solved in the following manner: during (or after) the filling of the barrel, filling data, such as the filling date and identification concerning the type of fluid charged in such as the beer grade, the filling volume, a sequential filling number, etc. are transmitted from the transmitting/receiving device to the transponder and are there stored as data set in a poll able manner is [sic] such a way that the data even at a

later point in time cannot only be read out elsewhere but can also be updated.

As shown above, the data stored in Keuper's barrel tag transponder pertains to a barrel's contents. **The data stored in Keuper's barrel tag transponder does not include insurer information.** In fact, information such as the filling data disclosed by Keuper has absolutely nothing to do with insurer information. Furthermore, as argued above, PIPinsure fails to teach or suggest a data file containing both item information and insurer information. Thus, neither Keuper nor PIPinsure, taken singly or in combination, teach or suggest a method for arranging insurance for an item, wherein the method comprises, in part, storing the data file, containing item information and insurer information, in a memory device that accompanies the item.

In the response to arguments section of the Final Office Action mailed April 3, 2007, the Examiner argues that "PIPinsure teaches insurer information" and that "Keuper teaches storing data files in memory devices that accompany an item." **However, nothing in PIPinsure, Luchs and Keuper, even if considered in combination, teaches or suggests storing insurer information in a data file in a memory device that accompanies the item during shipment.** The PIPinsure reference, as argued above, does not teach or suggest, even if combined with Keuper and Luchs, insurer information that would accompany an item, as in Applicants' claim. Instead, PIPinsure merely describes general savings information, such as an estimate of insurance savings that a potential customer may expect. Nor does Keuper teach storing the data file, containing item information and insurer information, in a memory device that accompanies the item. Thus, whether considered singly or in combination, PIPinsure, Luchs and Keuper do not teach or suggest storing the data file, containing item information and insurer information, in a memory device that accompanies the item.

Furthermore, the Examiner has failed to provide a proper reason for combining the teaching of PIPinsure and Luchs with the teachings of Keuper. The Examiner asserts: "One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Keuper with the teachings of PIPinsure and Luchs

with the motivation of acquiring shipment-handling data on an item.” However, PIPinsure teaches relying on the shipment carrier to maintain shipment-handling data for a particular item. For instance, PIPinsure teaches that prior to filing a claim with PIPinsure, a user should “[f]ile a tracer with the carrier without delay when a package is lost” and a copy of the carrier’s tracer form is a required document when filing a claim (PIPinsure, page 5). Thus, one of ordinary skill in the art would not be motivated to modify the teachings of PIPinsure to include the “keg tag” of Keuper to acquire shipment-handling data on an item because PIPinsure already utilizes a specific method of acquiring shipment-handling data – namely relying upon the independent shipping carriers to track shipments. One of ordinary skill in the art would simply use the teachings of PIPinsure to acquire shipment-handling data on an item. Moreover, “acquiring shipment-handling data on an item” provides no reason to also store insurer information with the item information in the data file in a memory device that accompanies the item.

In the Response to Arguments section of the Final Office Action mailed April 3, 2007, the Examiner merely states, “Examiner respectfully submits that the motivations to combine the references used throughout this rejection are adequate.” However, stating a conclusory opinion that the motivations are adequate fails to address Applicant’s specific arguments regarding the fact that there is no reason why one of ordinary skill would modify the teachings of PIPinsure, Luchs and Keuper, as required by the Examiner’s rejection. For instance, Applicant has argued that the Examiner’s stated reason, namely that of “acquiring shipment-handling data on an item” is not adequate for various reasons, such as because PIPinsure already describes a perfectly reasonable method for acquiring shipment-handling data. Moreover, “acquiring shipment-handling data on an item” provides no reason to also store insurer information with the item information in the data file in a memory device that accompanies the item. Thus, rather than providing a proper reason to modify the cited art, the Examiner has merely stated the Examiner’s conclusory opinion, unsupported by any explanation or evidence, that the reasons are adequate. The Examiner has clearly failed to meet the burden of establishing a *prima facie* obviousness rejection.

Additionally, it would not make sense to modify PIPinsure and Luchs to use the keg tags of Keuper. Since, as noted above, PIPinsure provides insurance for packages shipped using independent carriers, such as Airborne Express, DHL, FedEx, UPS, and the U.S. Postal Service, among others. Thus, the packages being insured never actually pass through a PIPinsure facility. In order to use the keg tags of Keuper, PIPinsure would have to receive each item, attach Keuper keg tag storing a data file including both item identification and insurer information, and then ship the package via the appropriate carrier. Clearly, such a process is not described by the references. Nor does it make sense to modify PIPinsure as suggested by the Examiner. The Examiner has failed to rebut these arguments.

Furthermore, the references are not properly combinable because Keuper is non-analogous art to PIPinsure and Luchs. One of ordinary skill in the art would not combine teachings directed to beer keg tags with the teachings of PIPinsure. The keg tags of Keuper are not analogous art to PIPinsure.

Moreover, for at least the reasons given above, even if the references were combined, such a combination would not result in Applicant's claimed invention. To establish a *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. For the numerous reasons discussed above, the cited art clearly does not teach or suggest all limitations combined as recited in the currently pending claims.

Furthermore, the PIPinsure reference has not been shown to be prior art to the present application. The Examiner has not properly established a publication date of the PIPinsure reference. The Examiner relies on the website <http://www.archive.org> for establishing that the PIPinsure reference was available as of 2000. However, there is no guarantee that the dates or even the content of what is supplied by

<http://www.archive.org> is accurate. Applicant notes that the Terms of Use for <http://www.archive.org> (see <http://www.archive.org/about/terms.php>) state:

You understand and agree that the Archive makes no warranty or representation regarding the accuracy, currency, completeness, reliability, or usefulness of the content in the Collections, that the Site or the Collections will meet your requirements, that access to the Collections will be uninterrupted, timely, secure, or error free, or that defects, if any, will be corrected. We make no warranty of any kind, either express or implied.

Thus, since <http://www.archive.org> does not guarantee the accuracy of its collections, Applicant asserts that it is not proper to rely on <http://www.archive.org> to establish a publication date. Furthermore, even if the PIPinsure reference was published prior to Applicant's date of invention, there is no guarantee that the copy downloaded by the Examiner is an *accurate copy of what was published*. **This is especially true since <http://www.archive.org> specifically states that they do not guarantee the accuracy of their content.**

For the above reasons, Applicant asserts that there is insufficient evidence of record to establish that the PIPinsure reference downloaded by the Examiner qualifies as prior art. Also, as noted above, even if the PIPinsure reference is prior art, PIPinsure in view of Keuper in further view of Luchs fails to teach or suggest the specific limitations of claim 1 as demonstrated above.

Thus, the rejection of claim 1 is unsupported by the cited art and removal thereof is respectfully requested.

Claim 19

In regard to claim 19, Applicants assert that the rejection of claim 19 is unsupported by the cited art for at least reasons similar to those presented above with respect to claim 1.

Furthermore, the cited art fails to teach or suggest a server configured to search a database for a cost effective insurance for the item, wherein the cost effective insurance provides maximum insurance coverage for the item during shipment for the least cost. The Examiner asserts that claim 19 is rejected for the same reasons provided for claims 1, 6, and 9. However, neither claims 1, 6, or 9 recite the limitation: search a database for a cost effective insurance for the item, wherein the cost effective insurance provides maximum insurance coverage for the item during shipment for the least cost. Nor does the cited art teach such limitation. Moreover, the Examiner's statement that the rejection of claim 19 "substantially repeated the same limitations" as claims 1, 6 and 9 does not actually address the **actual differences** between the claims.

Thus, the rejection of claim 19 is unsupported by the cited art and removal thereof is respectfully requested. Similar remarks apply to claim 20.

Claim 4

In regard to claim 4, the cited art fails to teach or suggest forwarding copies of at least a portion of the data file via the network to one or more of the parties involved in the shipping, wherein the parties include at least an originator of the request to ship the item, a recipient of the item at the final destination, and at least one insurance company. The Examiner cites page 8 to support the erroneous assertion that PIPinsure discloses "forwarding copies of at least a portion of the data file via the network to at least one insurance company." As described above with respect to claim 1, PIPinsure fails to teach generating such data file. By extension, PIPinsure cannot teach or suggest forwarding copies of at least a portion of such data file to any entity, much less forwarding copies of at least a portion of the data file via the network to one or more of the parties involved in the shipping, wherein the parties include at least an originator of the request to ship the item, a recipient of the item at the final destination, and at least one insurance company.

The Examiner further cites the Abstract of Kadaba to support the erroneous assertion that Kadaba discloses “forwarding copies of at least a portion of the data file via the network to one or more of the parties involved in the shipping, wherein the parties includes at least an originator of the request to ship the item, a recipient of the item at the final destination.” The Abstract fails to mention anything at all about forwarding copies of at least a portion of the data file via the network to one or more of the parties involved in the shipping, wherein the parties include at least an originator of the request to ship the item and a recipient of the item at the final destination. While Kadaba does mention a “portable data entry and data processing device to obtain signatures of recipients” (Abstract, emphasis added), Kadaba fails to teach or suggest forwarding copies of at least a portion of a data file (that comprises item information and insurer information) to such recipients. Additionally, Kadaba fails to teach or suggest forwarding copies of at least a portion of such a data file to an originator of the request to ship the item. **In fact, Kadaba fails to mention anything at all about a data file comprising item information and insurer information.** Clearly, Kadaba, even when combined with the teachings of PIPinsure and Keuper, fails to teach or suggest the specific limitations of claim 4.

Furthermore, Applicant asserts that the Examiner has failed to state a proper reason as to why one of ordinary skill in the art would have combined the teachings of Kadaba with the teaching of PIPinsure, Keuper, and Luchs. The Examiner asserts:

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Kadaba with the combined teachings of PIPinsure, Keuper And Luchs with the motivation of providing an improved parcel tracking system capable of sharing parcel data with other computers (Kadaba: col. 3, lines 40-64). (emphasis added)

However, the Examiner has merely provided a reason to use the teachings of Kadaba alone, not a reason to combine the teaching of Kadaba with the teachings of PIPinsure and Keuper in order to create Applicant’s claimed invention. Indeed, one seeking to “provid[e] an improved parcel tracking system capable of sharing parcel data with other

computers” would simply use the teachings of Kadaba alone (*see e.g.*, Kadaba column 3, lines 40-64).

Thus, for at least the reasons presented above, the rejection of claim 4 is unsupported by the cited art and removal thereof is respectfully requested.

Claim 5

In regard to claim 5, the cited art fails to teach or suggest the method of claim 1, further comprising forwarding copies of the data file via the network to one or more predetermined email addresses. Furthermore, the Examiner takes official notice that “it is old and well known within the computer arts to transmit information via a network to an email address.” Pursuant to M.P.E.P. § 2144.03, Applicant previously traversed the Examiner’s taking of official notice in the context of Applicant’s claimed invention. Applicant asserts that it was not well known in the prior art to transmit copies of a data file including item information and insurer information via a network to one or more predetermined email addresses, *in the specific context of Applicants’ invention*. In fact, as discussed above, neither PIPinsure nor Keuper nor Luchs, taken singly or in combination, disclose a generating a data file with item information indicative of the item and insurer information indicating one or more terms of said cost effective insurance much less forwarding copies of that type of data file via the network to one or more predetermined email addresses. Pursuant to M.P.E.P. § 2144.03 Applicant asserted in a previous response that the Examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See also 37 CFR 1.104(c)(2), (d)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

The Examiner failed to provide any documentary evidence to support the Official Notice. Instead, the Examiner states, “Applicant’s traversal of Official Notice was inadequate because Applicant did not state why the noticed fact is not considered to be common knowledge or well-known in the art” and “[a]s such, the features rejected via Official Notice are deemed to be admitted prior art.” However, Applicant submits that

Applicant adequately traversed the Examiner's taking of Official Notice and that it was not well known *in the context of Applicants' invention* to transmit copies of a data file including item information and insurer information via a network to one or more predetermined email addresses. Moreover, it is the Examiner, not the Applicant, who has the burden of proof to produce the factual basis for the rejection of an application under sections 102 and 103. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968).

Furthermore, Applicant's claim does not recite merely transmitting information via a network to an email address. Instead, claim 5 requires that copies of a specific data file that is also stored in a memory device that accompanies the item being shipped are forwarded to one or more predetermined email addresses. This *specific limitation* is not disclosed by any evidence of record. Even if general prior art email transmissions referred to by the Examiner we combined with PIPinsure and Keuper, it would not suggest the specific limitation recited in claim 5.

Furthermore, the Examiner has not provided any reason to modify the systems of PIPinsure, Keuper and Luchs according to the Examiner's Official Notice. Therefore, a *prima facie* rejection has not been stated.

Thus for at least the reasons presented above, the rejection of claim 5 is unsupported by the cited art and removal thereof is respectfully requested.

Claim 6

In regard to claim 6, the cited art fails to teach or suggest the method of claim 1 further comprising forwarding a copy of the data file via a network to a central server. The Examiner admits PIPinsure fails to disclose this limitation. The Examiner relies on Keuper and Kadaba to disclose forwarding a copy of the data file via a network to a central server. The Examiner cites Kadaba. Kadaba discloses (column 2, lines 30-54):

Generally described, the present invention provides an electronic parcel tracking system for use by an organization, comprising an intelligent hand-held, portable data entry and data processing device, which includes a wand-mounted symbol reader, a data entry and display screen capable of receiving and displaying information, including signature information, input by contact with the screen, an information storage device, a data transfer device, and a processor connected to the reader, the screen, the storage device, and the data transfer device. The processor is configured to associate and store in the information storage device data related to a particular parcel, including symbol information read by the reader, signature information acquired by the screen, and keyed information acquired by the screen, and to respond to queries about the particular parcel entered via the screen by displaying the data associated with the parcel.

Preferably, the data transfer device is selectively operable to transfer information from the information storage device to a personal computer system located at a parcel receiving location of the organization. Also, the portable data entry device may be equipped with a modem for transferring information related to a particular parcel between the information storage device and a central computer system located at a parcel delivery firm. (emphasis added)

Clearly, Kadaba fails to disclose, in the cited art or elsewhere, a data file comprising insurer information. Instead, Kadaba teaches storing, in an information storage device, symbol information, signature information, and keyed information. Furthermore, neither PIPinsure, Keuper, nor Kadaba, taken singly or in combination, teach or suggest a data file comprising insurer information. The Examiner's combination of cited art fails to teach or suggest forwarding a copy of the data file via a network to a central server, wherein the data file comprises insurer information.

In the Response to Arguments Final Office Action mailed April 3, 2007, the Examiner argues that since the physical structure of Keuper and Kadaba's system is capable of forwarding a (any) data file to a central server, the combination or prior art therefore teaches the specific limitation of forwarding a copy of data file that includes item information and insurer information that accompanies an item to a central server, as recited in Applicants' claim. The Examiner's argument regarding a "recitation of intended use" and "structural differences" is irrelevant to Applicants' specific *method*

claim limitation. Claim 6 does not recite an intended use of a physical structure. Instead, Claim 6 recites a specific method limitation of *copying* a specific data file, generated as recited in claim 1, to central server via a network. As noted above, the Examiner's combination of cited art does not teach or suggest the specific method limitation recited in claim 6. Whether or not a system resulting from the Examiner's combination of cited art would or would not be capable of copying such a data file via a network to a central server is irrelevant to the fact that the combination of cited art fails to teach or suggest such a limitation. Moreover, the Examiner still has not addressed the fact that none of the cited references teach a data file comprising insurer information. Thus, even if the references were combined as suggested by the Examiner, such a combination would not result in Applicant's claimed invention as recited in claim 6.

Furthermore, Applicant asserts that the Examiner has failed to state a proper reason as to why one of ordinary skill in the art would have combined the teachings of Kadaba with the teaching of PIPinsure, Keuper, and Luchs. The Examiner asserts:

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Kadaba with the combined teachings of PIPinsure, Keuper, and Luchs with the motivation of providing an improved parcel tracking system capable of sharing parcel data with other computers (Kadaba: col. 3, lines 40-64). (emphasis added)

However, the Examiner has merely provided a reason to use the teachings of Kadaba alone, not a reason to combine the teaching of Kadaba with the teachings of PIPinsure and Keuper in order to create Applicant's claimed invention. Indeed, one seeking to "provid[e] an improved parcel tracking system capable of sharing parcel data with other computers" would simply use the teachings of Kadaba alone (*see e.g.*, Kadaba column 3, lines 40-64).

Thus, for at least the reasons presented above, the rejection of claim 6 is unsupported by the cited art and removal thereof is respectfully requested.

Claim 7

In regard to claim 7, the cited art fails to teach or suggest the method of claim 1, further comprising further comprising shipping the item using the least expensive routing. Furthermore, the Examiner takes official notice that “it is old and well known within the shipping and parcel delivery arts to ship items using the least expensive routing.” Pursuant to M.P.E.P. § 2144.03, Applicant traverses the Examiner’s taking of official notice *in the context of Applicant’s claimed invention*. Applicant asserts that it was not well known in the prior art to ship items using the least expensive routing *wherein the item is accompanied by a memory device that stores a data file containing at least item information and insurer information*. In fact, as discussed above, neither PIPinsure nor Keuper nor Luchs, taken singly or in combination, disclose shipping an item using the least expensive routing wherein the item is accompanied by a memory device that stores a data file containing insurer information. Pursuant to M.P.E.P. § 2144.03 Applicant asserted in a previous response that the examiner must provide documentary evidence if the rejection is to be maintained. See also 37 CFR 1.104(c)(2), (d)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

The Examiner failed to provide any documentary evidence to support the Official Notice. Instead, the Examiner states, “Applicant’s traversal of Official Notice was inadequate because Applicant did not state why the noticed fact is not considered to be common knowledge or well-known in the art” and “[a]s such, the features rejected via Official Notice are deemed to be admitted prior art.” However, Applicant submits that Applicant adequately traversed the Examiner’s taking of Official Notice and that it was not well known in the context of Applicants’ invention to ship items using the least expensive routing. There are many instance in which a more expensive routing may be used, such as to obtain faster shipping. Thus, even if shipping using the least expensive routing was known in other contexts, it was not known for the specific combination of limitations recited in claims 1 and 7.

Furthermore, the Examiner has not provided any reason to modify the systems of PIPinsure, Keuper, and Luchs according to the Examiner's Official Notice. Therefore, a *prima facie* rejection has not been stated.

Thus for at least the reasons presented above, the rejection of claim 7 is unsupported by the cited art and removal thereof is respectfully requested.

Claim 8

In regard to claim 8, the cited art fails to teach or suggest wherein the data file further comprises contact information for at least one of the insurance companies that will insure the item. The Examiner cites pages 2-3 of PIPinsure. While page 2-3 of PIPinsure discloses a phone number, address, and email address associated with the Parcel Insurance Plan, nowhere does PIPinsure teach or suggest that such information is comprised within a data file in a memory device that accompanies the item. The Examiner has not addressed the specific limitations of claim 8. Neither PIPinsure nor Keuper, taken singly or in combination, teach or suggest a data file, which comprises contact information for at least one of the insurance companies that will insure the item, in a memory device that accompanies the item. Applicants also note that the Examiner has not provided any reason as to why one of ordinary skill in the art would be motivated to combine the teaching of PIPinsure with the teachings of Keuper to create the invention as specified by the specific limitations of claim 8. Furthermore, even were such a combination to be made, it would not result in Applicants' claimed invention.

Thus, the rejection of claim 8 is unsupported by the cited art and removal thereof is respectfully requested.

Claim 9

Applicants assert the rejection of claim 9 is unsupported by the cited art for at least the reasons presented above with respect to claim 1. Furthermore,

Applicant asserts that the Examiner has failed to state a proper reason as to why one of ordinary skill in the art would have combined the teachings of Kadaba with the teaching of PIPinsure, Keuper, and Luchs. The Examiner asserts:

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Kadaba with the combined teachings of PIPinsure, Keuper, and Luchs with the motivation of providing an improved parcel tracking system capable of sharing parcel data with other computers (Kadaba: col. 3, lines 40-64). (emphasis added)

However, the Examiner has merely provided a reason to use the teachings of Kadaba alone, not a reason to combine the teaching of Kadaba with the teachings of PIPinsure, Keuper, and Luchs in order to create Applicant's claimed invention. Indeed, one seeking to "provid[e] an improved parcel tracking system capable of sharing parcel data with other computers" would simply use the teachings of Kadaba alone (*see e.g.*, Kadaba column 3, lines 40-64).

Thus, for at least the reasons presented above, the rejection of claim 9 is unsupported by the cited art and removal thereof is respectfully requested.

Claim 10

In regard to claim 10, the cited art fails to teach or suggest the method of claim 1, wherein storing the data file comprises data in an XML format. Furthermore, the Examiner takes official notice that "it is old and well know within the computer arts to store data in eXtensible Markup Language (XML) format." Pursuant to M.P.E.P. § 2144.03, Applicant traverses the Examiner's taking of official notice in the context of Applicant's claimed invention. Applicant asserts that it was not well known in the prior art to store a data file that comprises data in an XML format *wherein the data file is stored in a memory device that accompanies an item*. In fact, as discussed above, neither PIPinsure nor Keuper nor Luchs, taken singly or in combination, discloses that storing the data file comprises data in an XML format *where the data file is stored in a memory device that accompanies an item and where the data file includes at least item information and insurer information*. Pursuant to M.P.E.P. § 2144.03 Applicant asserted

in a previous response that the examiner must provide documentary evidence if the rejection is to be maintained. See also 37 CFR 1.104(c)(2), (d)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

The Examiner failed to provide any documentary evidence to support the Official Notice. Instead, the Examiner states, “Applicant’s traversal of Official Notice was inadequate because Applicant did not state why the noticed fact is not considered to be common knowledge or well-known in the art” and “[a]s such, the features rejected via Official Notice are deemed to be admitted prior art.” However, Applicant submits that Applicant adequately traversed the Examiner’s taking of Official Notice and that it was not well known in the context of Applicants’ invention to store a data file that comprises data in an XML format *wherein the data file is stored in a memory device that accompanies an item*. XML may be known in the prior art for other purposes, but it is not used in the prior art for a data file including the specific information recited in Applicant’s claims and stored in a memory device accompanying an item being shipped. Moreover, it is the Examiner, not the Applicant, who has the burden of proof to produce the factual basis for the rejection of an application under sections 102 and 103. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968).

Furthermore, the Examiner has not provided any reason to modify the systems of PIPinsure, Keuper and Luchs according to the Examiner’s Official Notice. Therefore, a *prima facie* rejection has not been stated.

Thus for at least the reasons presented above, the rejection of claim 10 is unsupported by the cited art and removal thereof is respectfully requested.

Claim 11

In regard to claim 11, the cited art fails to teach or suggest the method of claim 9, wherein the network data is exchanged in an XML format. Furthermore, the Examiner takes official notice that “it is old and well know within the computer arts to

exchange network data in an XML format.” Pursuant to M.P.E.P. § 2144.03, Applicant traverses the Examiner’s taking of official notice in the context of Applicant’s claimed invention. Applicant asserts that it was not well known in the prior art to exchange data in an XML format on a network *wherein the data includes at least item information and insurer information*. In fact, as discussed above, neither PIPinsure nor Keuper nor Luchs, taken singly or in combination, discloses exchanging data including both item information and insurer information in an XML format on a network. Pursuant to M.P.E.P. § 2144.03 Applicant asserts that the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See also 37 CFR 1.104(c)(2), (d)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). **The Examiner failed to provide any documentary evidence to support the Official Notice.** Instead, the Examiner states, “Applicant’s traversal of Official Notice was inadequate because Applicant did not state why the noticed fact is not considered to be common knowledge or well-known in the art” and “[a]s such, the features rejected via Official Notice are deemed to be admitted prior art.” However, Applicant submits that Applicant adequately traversed the Examiner’s taking of Official Notice and that it was not well known in the context of Applicants’ invention to exchange network data in an XML format. XML may be known in the prior art for other purposes, but it is not used in the prior art for the specific network data exchange recited in Applicant’s claims. Moreover, it is the Examiner, not the Applicant, who has the burden of proof to produce the factual basis for the rejection of an application under sections 102 and 103. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968).

Furthermore, the Examiner has not provided any reason to modify the systems of PIPinsure, Keuper and Luchs according to the Examiner’s Official Notice. Therefore, a *prima facie* rejection has not been stated.

Thus for at least the reasons presented above, the rejection of claim 11 is unsupported by the cited art and removal thereof is respectfully requested.

Claim 16

In regard to claim 16, eBay, even when combined with the teachings of PIPinsure, Keuper and Luchs, fails to teach or suggest wherein the data file further comprises one or more digital images of the item before, during, or after shipping. The Examiner cites eBay (eBay: Why eBay is Safe; How to Add a Photo to Your Item Listing) to disclose the above limitation. First, Applicants note that the content of eBay (<http://web.archive.org/web/19991110180343/http://www.eBay.com/index.html>) fails to disclose anything about “How to Add a Photo to Your Item Listing,” contrary to the Examiner’s assertion. Furthermore, the web page accessed through the hyperlink entitled “Why eBay is Safe” fails to disclose anything about digital images, much less wherein the data file, which accompanies the item, further comprises one or more digital images of the item before, during, or after shipping.

Furthermore, the eBay reference has not been shown to be prior art to the present application. The Examiner has not established a publication date of the eBay reference. The Examiner relies on the website <http://www.archive.org> for establishing that the eBay reference was available as of 1999. However, there is no guarantee that the dates or even the content of what is supplied by <http://www.archive.org> is accurate. Applicant notes that the Terms of Use for <http://www.archive.org> (see <http://www.archive.org/about/terms.php>) state:

You understand and agree that the Archive makes no warranty or representation regarding the accuracy, currency, completeness, reliability, or usefulness of the content in the Collections, that the Site or the Collections will meet your requirements, that access to the Collections will be uninterrupted, timely, secure, or error free, or that defects, if any, will be corrected. We make no warranty of any kind, either express or implied.

Thus, since <http://www.archive.org> does not guarantee the accuracy of its collections, Applicant asserts that it is not proper to rely on <http://www.archive.org> to establish a publication date. Furthermore, even if the eBay reference was published prior to Applicant’s date of invention, there is no guarantee that the copy downloaded by the Examiner is an *accurate copy of what was published*. **This is especially true since**

<http://www.archive.org> specifically states that they do not guarantee the accuracy of their content.

Furthermore, when attempting to access the link for the eBay reference at <http://web.archive.org/web/19991110180343/http://www.eBay.com/index.html>, it is noted that not all portions of the reference are available under that date. For example, the portion of eBay related to “How to Add a Photo to Your Item Listing” is not present. Thus, contrary to the Examiner’s assertion, it does not appear that <http://web.archive.org/web/19991110180343/http://www.eBay.com/index.html> has a record of all portions of eBay being publicly available as of 1999.

For the above reasons, Applicant asserts that there is insufficient evidence of record to establish that the eBay reference downloaded by the Examiner qualifies as prior art. Also, as noted above, even if the eBay reference is prior art, PIPinsure in view of Keuper in view of Luchs in further view of eBay fail to teach or suggest wherein the data file, which accompanies the item, further comprises one or more digital images of the item before, during, or after shipping.

Thus for at least the reasons presented above, the rejection of claim 16 is unsupported by the cited art and removal thereof is respectfully requested.

Claim 17

In regard to claim 17, PIPinsure in view of Keuper in further view of Chen fails to teach or suggest wherein the data file further comprises one or more digital images of the item showing the physical condition of the item upon receipt. The Examiner cites the Abstract of Chen, which is reproduced below:

A communications network for processing insurance claims of objects. The communications network including claim terminals and repair terminals, each having a processor, a display monitor, and a mass storage device, for inputting and sending object-identification data, parts graphics images, and images from the claims terminals to the repair terminals through a communications channel. The repair terminals compute repair

and replacement estimates and send the estimates to the claim terminal. The object-identification data include information stored in digital form for a multiplicity of objects. The sum of the costs for repairing an object or a part of an object versus the cost for replacing the object or the part of a object is compared. An imaging device may be used for capturing an electronic image in digital form of the damaged object. The display monitor displays the electronic image along with lists of parts of the damaged object, a parts description, or with a selected first part and a parts graphics image. A method for processing insurance claims of objects is also provided. (emphasis added)

Chen describe an imaging device for capturing an electronic image of a damaged object. **Nowhere does Chen teach or suggest that his electronic image is comprised within a data file that is stored in a memory device that accompanies the item being shipped.** Accordingly, Chen, even when combined with the teaching of PIPinsure, Keuper and Luchs, fails to teach or suggest wherein the data file further comprises one or more digital images of the item showing the physical condition of the item upon receipt.

The Examiner further asserts that “taking photographs of items to document the physical condition of the items at different times (e.g., after shipment, etc.) for, *inter alia*, evidentiary and/or insurance claim purposes is notoriously well known” and cites parcel carriers, such as FedEx and UPS, as well as car rental agencies in support of his assertion. First, **Applicant does not claim “taking photographs of items to document the physical condition of the items at different times (e.g., after shipment, etc.) for, *inter alia*, evidentiary and/or insurance claim purposes.”** Therefore the Examiner’s comment is not relevant. Instead, Applicant claims wherein the data file further comprises one or more digital images of the item showing the physical condition of the item upon receipt. The Examiner has not addressed the specific limitations of claim 17. Furthermore, the Examiner’s assertions related to FedEx, UPS, and car rental agencies are not supported by any **evidence of record**. Accordingly, a rejection that relies on such assertions is improper.

Furthermore, Applicants assert that the Examiner has not stated a proper reason as to why one of ordinary skill in the art would have combined the teachings

of Chen with the teachings of PIPinsure, Keuper and Luchs to create Applicant's claimed invention. The Examiner asserts:

One of ordinary skill in the art would have found it obvious at the time of the invention to combine the teachings of Chen and knowledge generally available to one having ordinary skill in the art with the combined teaching of PIPinsure and Keuper with the motivation of providing a means for assessing damage for insurance claim processing purposes (Chen: Abstract). (emphasis added)

However, one seeking to "provid[e] a means for assessing damage for insurance claim processing purposes" would simply use Chen's system alone (*see e.g.*, Chen, Abstract). The Examiner has merely stated a reason for one skilled in the art to use the system of Chen, not a reason as to why one of ordinary skill in the art would be motivated to combine the teachings of Chen with the teachings of PIPinsure, Keuper and Luchs to create Applicant's claimed invention.

Thus for at least the reasons presented above, the rejection of claim 17 is unsupported by the cited art and removal thereof is respectfully requested.

Claim 18

In regard to claim 18, the cited art fails to teach or suggest wherein the memory device comprises an air testing device configured to test air samples for contaminants and to store test results in the data file. The Examiner cites column 2, lines 25-35 of Kepler, which is reproduced below:

...probe through the film patch. An air contaminant detection apparatus is interconnected with the probe such that a test sample of air from within the shipping container may be admitted to the air contaminant detection apparatus. A means for indicating the presence of a contaminant is further provided along with an apparatus for sorting the shipping container containing a refrigerator in response to a presence of the contaminant.

Accordingly, an object of the present invention is to detect the presence of contaminants in the air contained in a shipping container.

The Examiner also cites the Abstract of Keuper. While Kepler discloses an air contaminant detection apparatus, and Keuper discloses a “keg tag,” neither Kepler nor Keuper, taken singly or in combination, teach or suggest a memory device, which accompanies the item, that comprises an air testing device configured to test air samples for contaminants and to store test results in the data file. In fact, Kepler actually explicitly does not teach a memory device by teaching an air contaminant detection apparatus (*see e.g.*, Figure 1, item 30; column 3, lines 30-50) that is separate from and does not accompany Kepler’s shipping container (*see e.g.*, Figure 1, item 12; column 3, lines 5-29).

Thus for at least the reasons presented above, the rejection of claim 18 is unsupported by the cited art and removal thereof is respectfully requested.

CONCLUSION

Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5596-00901/RCK.

Respectfully submitted,

/Robert C. Kowert/

Robert C. Kowert, Reg. #39,255
Attorney for Applicant

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.
P.O. Box 398
Austin, TX 78767-0398
Phone: (512) 853-8850

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